

REMARKS

Amendments

Claims 1 and 23 are amended to delete references to derivatives and solvates. These amendments place the claims in condition for allowance by rendering moot all pending rejections. Entry of the amendments is respectfully requested.

Restriction

Applicants request rejoinder of the withdrawn method claims pursuant to MPEP 821.04.

Elected Species Not Rejected in view of Prior Art

In the May 28, 2008 Office Action, it is stated that the elected compound was not allowable. However, the issue regarding examination in accordance with MPEP §803.2 is whether the elected species of the Markush claim is found to be anticipated or obvious by prior art. In the instant case, the rejections have failed to demonstrate that the elected species of 1-N-[(4-chlorophenyl)]-2-N-[[4-(3-oxomorpholin-4-yl)phenyl]]-(2R,4R)-4-hydroxypyrrolidine-1,2-dicarboxamide is anticipated or obvious in view of prior art. In fact, the only prior art rejection presented did not reject claim 16, which encompasses the elected species.

Thus, examination should proceed in accordance with MPEP §803.2. Clarification as to the scope of examination is requested.

Rejection under 35 USC 112, first paragraph

Claims 1, 23, 29, 30, 32, 43-46, 56, 57, and 60 are rejected under 35 USC 112, first paragraph, as allegedly lacking enablement with respect to solvates. This rejection is respectfully traversed for the reasons of record.

However, for purposes of furthering prosecution, claims 1 and 23 are amended to delete references to solvates. These amendments render the instant rejection moot. Withdrawal of the rejection is requested.

Rejection under 35 USC 112, second paragraph

Claims 1, 23, 29, 30, 32, 43-46, 56, 57, and 60 are rejected under 35 USC 112, first paragraph, as allegedly being indefinite with respect to the term derivatives. This rejection is respectfully traversed for the reason of record.

However, for purposes of furthering prosecution, claims 1 and 23 are amended to delete references to derivatives. These amendments render the instant rejection moot. Withdrawal of the rejection is requested.

Obviousness-type Double Patenting Rejection

Claims 1, 23, 29, and 30 remain provisionally rejected as allegedly being obvious in view of claims 40-49 of Serial No. 11/575,711. This rejection is respectfully traversed.

At page 5 of the November 7, 2008 Office Action it is stated that "This ground of rejection is being maintained as there are other outstanding grounds of rejection remaining."

As all other grounds of rejection are rendered moot by the amendments, withdrawal of the instant rejection is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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Date: December 16, 2008